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DATE: 4 August 2006TO: EXAMINER: Mark Henderson
GROUP 3722
U.S. PATENT OFFICEFAX NO. 703-872-9302FROM: Thomas Strouse
PHONE NO. 585-588-2728FAX NO. (585) 477-4646RE: U.S. Serial No. 10/762,668
Filed 1/22/04
Inventor(s): David L. Patton
Docket No.: 80521B

Attached is applicant's Appeal Brief.

Total Pages Including Cover Sheet 17

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Docket 80521BTJS
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
David L. PattonA METHOD FOR PRINTING AND
VERIFYING LIMITED EDITION
STAMPS

Serial No. 10/762,668

Filed January 22, 2004

Group Art Unit: 3722
Confirmation No. 5162
Examiner: Mark T. HendersonI hereby certify that this correspondence was sent by
facsimile transmission to the United States Patent and
Trademark Office on the date set forth below.Paula West
Paula West
8-4-06
DateMail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTALEnclosed herewith is Appellants' Appeal Brief for the above-identified
application.The Commissioner is hereby authorized to charge the Appeal Brief filing
fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of
this letter is enclosed.

Respectfully submitted,

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Attorney for Appellants
Registration No. 53,950If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the
Examiner is requested to communicate with Eastman Kodak Company Patent Operations at
(585) 477-4656.

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Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1, 2, 4-6 and 8 which was contained in the Office Action mailed March 1, 2006.

A timely Notice of Appeal was mailed June 1, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1, 2, 4-6 and 8 are pending in the application. Claims 3 and 7 are cancelled.

Appendix I provides a clean, double-spaced copy of the claims 1, 2, 4-6 and 8 on appeal.

Status Of Amendments

Office Action mailed June 16, 2004.

Amendment mailed September 15, 2004.

Final Office Action mailed December 15, 2004.

116 Amendment mailed February 22, 2005.

Office Action mailed March 10, 2005.

Amendment mailed June 28, 2005.

Final office Action mailed March 1, 2006.

116 Amendment mailed April 26, 2006.

Advisory Action mailed May 15, 2006.

Notice of Appeal mailed June 1, 2006.

Summary of Claimed Subject Matter

With respect to independent claim 1, the Appellant's invention relates to a limited edition official postal stamp 20. *See at least* page 5, lines 8-9 and Figs. 1-2; page 7, lines 14-24; *see also* page 1, line 26 – page 2, line 5; page 3, lines 17-25. More particularly, the limited edition official postal stamp 20 includes a visible first indicia 10 identifying said limited edition stamps as being a limited edition (*See at least* page 5, lines 9-10 and Fig. 1) and a second indicia 30 not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp, the second indicia is made from an ink that can be seen when viewed under UV or infrared light. *See at least* page 5, lines 9-27 and Fig. 1. The limited edition official postal stamp 20 also includes a third indicia 50 for identifying a printer and/or a location where said limited edition stamp was printed. *See at least* page 5, line 15 - page 6, line 4 and Fig. 1.

With respect to independent claim 8, the Appellant's invention relates to a limited edition official postal stamp 20. *See at least* page 5, lines 8-9 and Figs. 1-2; page 7, lines 14-24. More particularly, the limited edition official postal stamp 20 includes a visible first indicia 10 identifying said limited edition stamps as being a limited edition (*See at least* page 5, lines 9-10 and Fig. 1) and a second indicia 30 not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp. *See at least* page 5, lines 9-27 and Fig. 1. The limited edition official postal stamp 20 also includes a third indicia 50 for identifying a printer and/or a location where said limited edition stamp was printed, the indicia is made from an ink that can be seen when viewed under UV or infrared light. *See at least* page 5, line 15 - page 6, line 4 and Fig. 1.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the invention of claims 1, 2, 4-6 and 8 are patentable over Guttag (US Pat. No. 5,120,089) in view of Martin (US Pat. No. 5,601,683).

Arguments

CLAIMS 1, 2, 4-6 AND 8 ARE PATENTABLE OVER GUTTAG IN VIEW OF MARTIN BECAUSE GUTTAG AND MARTIN, ALONE OR IN COMBINATION, FAIL TO SHOW ALL OF THE ELEMENTS RECITED IN CLAIMS 1, 2, 4-6 AND 8.

1. **CLAIMS 1, 2, 4-6 AND 8 ARE PATENTABLE OVER GUTTAG IN VIEW OF MARTIN BECAUSE GUTTAG AND MARTIN, ALONE OR IN COMBINATION, DO NOT DISCLOSE CONFIRMING THAT SAID LIMITED EDITION STAMP IS A VALID LIMITED EDITION STAMP AS RECITED IN CLAIMS 1, 2, 4-6 AND 8.**
 - a. **GUTTAG DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST A SECOND INDICIA NOT CAPABLE OF BEING SCANNED AND FURTHER NOT VISIBLE UNDER NORMAL VIEWING CONDITIONS FOR CONFIRMING THAT SAID LIMITED EDITION STAMP IS A VALID LIMITED EDITION STAMP AS RECITED IN INDEPENDENT CLAIMS 1 AND 8.**

Guttag fails to teach or suggest at least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp as recited in claims 1 and 8. Rather, Guttag discloses that an expert can serially number various copies of a philatelic item expertized by him or her, e.g., serialize a number of "inverted Jenny" defective stamps known at the time. Appellant submits that applying serial or series numbers to stamps found to be defective is not the same as intentionally providing a limited edition stamp. Thus, Guttag does not disclose a limited edition stamp. Moreover, the final Office Action admits

that Guttag does not disclose a second indicia as recited by Appellant's independent claims. Moreover, Guttag does not disclose a second indicia for confirming that the limited edition official postal stamp is a valid limited edition official postal stamp, i.e., at least a stamp being one out of a predetermined number. See claim 2 and page 7 of Appellants' Specification.

In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . . dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

Guttag merely discloses that an expert's authentication mark is applied to a philatelic item and covered with plastic 24. See Col. 2, lines 42-46. However, Guttag does not disclose that the philatelic item is a limited edition stamp, and furthermore, that a second indicia is not capable of being scanned and further not visible under normal viewing conditions confirms that said limited edition stamp is a valid limited edition stamp. Accordingly, the Office Action's use of inherency does not provide for confirming that a limited edition official postal stamp is a valid limited edition official postal stamp. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1269, 20 USPQ 1746, 1749 (Fed. Cir. 1991).

Thus, Guttag does not teach, expressly or inherently, at least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition

stamp. Therefore, Appellant respectfully submits that Appellant's claims are patentable over Guttag.

b. MARTIN DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST A SECOND INDICIA NOT CAPABLE OF BEING SCANNED AND FURTHER NOT VISIBLE UNDER NORMAL VIEWING CONDITIONS FOR CONFIRMING THAT SAID LIMITED EDITION STAMP IS A VALID LIMITED EDITION STAMP AS RECITED IN INDEPENDENT CLAIMS 1 AND 8.

Martin fails to remedy the deficiencies of Guttag as Martin also fails to teach or suggest at least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp as recited in claim 1. Rather, Martin discloses a photocopy-resistant background pattern or logo to prevent forgery. *See Abstract*. However, Martin, does not provide a confirming that a limited edition official postal stamp is a valid limited edition official postage stamp, i.e., a stamp being one out of a predetermined number. Further, the reference to Burnham in the Martin reference also fails to remedy the deficiencies of Guttag and Martin as Burnham also fails to teach or suggest at least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp as recited in claims 1 and 8. Rather, Burnham merely teaches an improvement on the moiré pattern used to provide security against counterfeiting in a valuable document. *See Burnham Col. 1, lines 39-61*.

Thus, Martin or Burnham do not teach, expressly or inherently, least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp. Therefore, Appellant respectfully submits that Appellant's claims are patentable over Martin.

c. CONCLUSION

Thus, Gutttag, Martin and Burnham, alone or in combination, do not teach expressly or inherently at least a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp. Therefore, Appellant respectfully submits that Appellant's claims are patentable over the cited references.

2. CLAIMS 1, 2, 4-6 AND 8 ARE PATENTABLE OVER GUTTAG IN VIEW OF MARTIN BECAUSE GUTTAG AND MARTIN, ALONE OR IN COMBINATION, FAIL TO PROVIDE A THIRD INDICIA FOR IDENTIFYING A PRINTER AND/OR A LOCATION WHERE SAID LIMITED EDITION STAMP WAS PRINTED AS RECITED IN CLAIMS 1, 2, 4-6 AND 8.

a. GUTTAG DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST A THIRD INDICIA FOR IDENTIFYING A PRINTER AND/OR A LOCATION WHERE SAID LIMITED EDITION STAMP WAS PRINTED AS RECITED IN INDEPENDENT CLAIMS 1 AND 8.

Gutttag fails to teach or suggest at least a third indicia for identifying a printer and/or a location where said limited edition stamp was printed. The final Office Action states that "'flaws' or 'imperfections' unique to each printer wherein the print acts as . . . pseudo fingerprint[s]" and the "'fingerprints' are inherent to the printer which forms the stamp defining the third indicia." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1269, 20 USPQ 1746, 1749 (Fed. Cir. 1991). The Appellant respectfully submits that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127.

b. MARTIN DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST A THIRD INDICIA FOR IDENTIFYING A PRINTER AND/OR A LOCATION WHERE SAID LIMITED EDITION STAMP WAS PRINTED AS RECITED IN INDEPENDENT CLAIMS 1 AND 8.

Martin fails to teach or suggest at least a third indicia for identifying a printer and/or a location where said limited edition stamp was printed. The final Office Action states that "'flaws' or 'imperfections' unique to each printer wherein the print acts as . . . pseudo fingerprint[s]" and the "'fingerprints' are inherent to the printer which forms the stamp defining the third indicia." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1269, 20 USPQ 1746, 1749 (Fed. Cir. 1991). The Appellant respectfully submits that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127.

c. CONCLUSION

Accordingly, Gutttag and Martin, alone or in combination, do not teach expressly or inherently at least a third indicia for identifying a printer and/or a location where said limited edition stamp was printed. Therefore, Appellant respectfully submits that Appellant's claims are patentable over the cited references.

CONCLUSION

In view of the above remarks, Appellants respectfully submit that claims 1 and 8 are patentable over the cited references. Because claims 2 and 4-6 depend from claim 1 and include the features recited in the independent claim as well as additional features, Appellants respectfully submit that claims 2 and 4-6 are also patentably distinct over the cited references. Nevertheless, Appellants are not conceding the correctness of the Examiner's rejection with respect to such dependent claims and reserves the right to make additional arguments if necessary.

Summary

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1, 2, 4-6 and 8.

Respectfully submitted,



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Appendix I - Claims on Appeal

1. A limited edition official postal stamp comprising:
a visible first indicia identifying said limited edition stamps as being a limited edition;
a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp, said second indicia is made from an ink that can be seen when viewed under UV or infrared light; and
a third indicia for identifying a printer and/or a location where said limited edition stamp was printed.
2. A limited edition stamp according to claim 1 wherein said first indicia identifies that said limited edition stamp is one out of a predetermined number.
4. A limited edition stamp according to claim 1 wherein said third indicia is not visible to the eye under normal viewing conditions.
5. A limited edition stamp according to claim 1 wherein said third indicia is not capable of being scanned.

6. A limited edition stamp according to claim 1 wherein said third indicia is made using an ink that can be seen when viewed under UV or infrared light.

8. A limited edition official postal stamp comprising:
a visible first indicia identifying said limited edition stamps as being a limited edition;

a second indicia not capable of being scanned and further not visible under normal viewing conditions for confirming that said limited edition stamp is a valid limited edition stamp; and

a third indicia for identifying a printer and/or a location where said limited edition stamp was printed, said indicia is made from an ink that can be seen when viewed under UV or infrared light.

Appendix II - Evidence

None

Appendix III – Related Proceedings

None